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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,752	12/12/2001	Daryl Carvis Cromer	RPS9 2001 0053	8650

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EXAMINER	
ARAQUE JR, GERARDO	
ART UNIT	**PAPER NUMBER**
3629	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/020,752	CROMER ET AL.	
	Examiner	Art Unit	
	Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-13 and 16-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-13 and 16-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1 – 18** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant fails to fully describe the mathematical process as to how a default system is determined.

The specification only discloses that a mathematical process of, "...multiplying the segment variable, inventory variable, and, where applicable, performance variable for each decision required in providing the default offering," but fails to actually show and give an example of how this process is carried out. Moreover, the applicant discloses that a default offering would be offered, but then discloses, "...If multiple default offerings are to be provide3d, then lower scores may be made part of the other default offerings. Thus, the default offerings can be built component by component in step 166." If the customer would have to end up choosing their components piece by piece what would the point be in providing a default offer when there can be more than one offer.

Furthermore, the applicant discloses that all that must be done to have a default offer is to multiply two variables (or 3 if applicable) and using the highest score as a means to provide a default offer. However, the applicant fails to disclose how to distinguish multiple high scores from one another. Specifically, how would the system deal with the following scenario?

a. segment variable = 0.1; inventory variable = 1.0; and performance variable = 1.0

b. segment variable = 1.0; inventory variable = 1.0; and performance variable = 0.1

in which the scores would be the following:

a. 1.0

b. 1.0

As it can be seen both scores are equal to each other yet both would produce two completely different systems. Further still, the applicant does not disclose how business segments would be treated for different business, i.e. game development vs. school administration. The current system does not show any indication of how this would be dealt. A game development business would want to focus more on high-end video cards, memory, and etc. while the school administration would want to focus more on a simple business that has high security, but in no need of the high-end hardware needed by the game developers. The current system would put a burden upon the customer in that they would need to research all the components on their own since the "rating" provided by the applicant is not useful.

3. The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 7 – 8 and 16 – 17** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Claim 7** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant is claiming to only validate "...a portion of the plurality of components against an inventory to determine whether the portion of the plurality of components is available." However, the applicant does not disclose how much a portion is. Moreover, if only a portion is being provided then how would a default offering be provided when all the options are not being provided to the customer? Furthermore, if only a portion of the plurality of components is being validated what happens to the rest of the components? Would that not affect the quality of the service that is being provided for the customer?

6. **Claim 8** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant is claiming whether only a portion of the plurality of components is available. However, the applicant does not disclose how much a portion is. Moreover, if only a portion is being provided then how would a default offering be provided when all the options are not being provided to the customer?

7. **Claim 16** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant is claiming to only validate "...a portion of the plurality of components against an inventory to determine whether the portion of the plurality of components is available." However, the applicant does not disclose how much a portion is. Moreover, if only a portion is being provided then how would a default offering be provided when all the options are not being provided to the customer? Furthermore, if only a portion of the plurality of components is being validated what happens to the rest of the components? Would that not affect the quality of the service that is being provided for the customer?

8. **Claim 17** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant is claiming whether only a portion of the plurality of components is available. However, the applicant does not disclose how much a portion is. Moreover, if only a portion is being provided then how would a default offering be provided when all the options are not being provided to the customer?

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 1 – 18** are rejected under 35 U.S.C. 101 because the number assigned to the segment variables are subjective and, therefore, fails to produce a "**concrete**"

result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or **unpredictable**. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. *See infra.*

The examiner understands the specifications as a person choosing these numbers and, as a result, will produce different results. Several people would have different views as to what is important and essential to a system and would assign different values based on their views. In order to have a system as disclosed by the applicant a programmer would have to input the values of each of the components. However, the views of what these values should be are subjective based on the individual(s) past experience and current knowledge base.

Furthermore, a customer who has extensive experience in computer systems would not always agree with what the vendor has displayed as a value to each of these components. In the event that a computer must be built for a business that requires

extensive graphics there would be different views on what components would be best for the type of business. For example, a company that uses engineering software such as AutoCAD/SolidWorks would require a video card and processor tailored for 3D engineering, a game developer would require a different video card and processor for the rendering of video games, and a company specializing in movie development would require a different video card and processor for the rendering of movies. How would the system be able to inform the consumer that Radeon would be a superior video card over a GeForce and, further still, what brand of each video card would be best for a given situation? As it can be seen, the applicant fails to disclose how the system would handle these situations and, as a result, would not produce a consistent default offer if the only options that are given for a business segment variable are commercial, small business, or individual consumers.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. **Claims 1 – 9, 10 – 18, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Lynch-Freshner et al. (US Patent 5,668,997).

13. In regards to **claim 1**, Henson discloses a method for a configuration system that allows a user to select the type of business that the computer will be used for, i.e.

home/personal use (Column 11 Lines 63 – 67) or a business user (Column 13 Lines 6 – 17, 29 – 33). Moreover, Henson discloses that the user has the option of selecting several types of configuration options, such as the desired performance level of the desired system (Figures 3, 4, and 5) and is presented with merchandising recommendations, such as generic text about a particular product, feature, and/or option (Column 7 Lines 22 – 29). Furthermore, before the user is presented with the configuration menu the online store that Dell offers provides the user with information of the system and the several default configurations of the chosen system based on the business segment provided by the consumer (http://web.archive.org/web/20000511045940/www.dell.com/us/en/dhs/products/line_desktops.htm http://web.archive.org/web/20000511074752/www.dell.com/us/en/dhs/products/series_dimen_desktops.htm http://web.archive.org/web/20000618194040/www.dell.com/us/en/dhs/offers/offer_3x_offer02.htm). The online store that is described in Henson also provides the user with several options of the default systems based on the selected business segment and performance level from the user (http://web.archive.org/web/20000618194040/www.dell.com/us/en/dhs/offers/offer_3x_offer02.htm).

However, Henson does not teach a dynamic system in which the information regarding the business segment and performance level is used to present the user with a default system.

However, Lynch-Freshner does teach a server that accepts parameters from a client and produces a window in accordance with the parameters with the use of a program, such as C++ (Column 4 Lines 60 – 66, Column 8 Lines 1 – 8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Lynch-Freshner to modify Henson to include a dynamic system of receiving parameters, such as a business segment and performance level, from a user and producing a window in accordance with the parameters, such as a default system based on the selected business segment and performance level.

14. In regards to **claims 2 and 11**, Henson discloses, "In accordance with the online store of the present disclosure, upon a recognition of who a particular customer is (e.g., or in what customer set), the online store takes out the unrelated options and departments, and does not present them to the customer as options for the customer (Column 13 Lines 29 – 34)."

15. In regards to **claims 3 – 4 and 12 – 13,** in order for the system described in Lynch-Freshner, some type of computational calculation must be made in order to present a user with a window that will be in accordance with the parameters that are received from the client. Moreover, Lynch-Freshner discloses a concept of polymorphism with the use of a C++ compiler, "...which allows objects and functions which have the same overall format, but which different data, to function differently in order to produce consistent results. For example, an addition function may be defined

as variable A plus variable B (A+B) and this same format can be used whether A and B are numbers, characters or dollars and cents (Column 7 Lines 56 – 62)."

16. In regards to **claims 7 and 16**, Henson discloses that the online store improves on the quality of buying online by optimizing on the responsiveness of customer requests, such as availability and speed (Column 16 Lines 58 – 61).

17. In regards to **claims 8 and 17**, Henson discloses the concept of lead-time on the online store. Warnings are presented to the customer in the case that there is a long lead-time. It is well known in the art that lead-time is closely associated with the amount of stock that is available for a particular item (http://www.xreferplus.com/entry.jsp?xrefid=1414013&secid=.-&hh=1 http://www.xreferplus.com/entry.jsp?xrefid=1412740) and that a long lead-time signifies that there is a low amount of a particular item in stock.

18. In regards to **claims 9 and 18**, Henson discloses that the online store will allow a customer to pick and choose which components the customer would want to improve on the base system that was provided (Column 6 Lines 18 – 21).

19. In regards to **claim 10**, Henson discloses configuration system that allows a user to select the type of business that the computer will be used for, i.e. home/personal use (Column 11 Lines 63 – 67) or a business user (Column 13 Lines 6 – 17, 29 – 33). Moreover, Henson discloses that the user has the option of selecting several types of configuration options, such as the desired performance level of the desired system (Figures 3, 4, and 5) and is presented with merchandising recommendations, such as generic text about a particular product, feature, and/or option (Column 7 Lines 22 – 29).

Furthermore, before the user is presented with the configuration menu the online store that Dell offers provides the user with information of the system and the several default configurations of the chosen system based on the business segment provided by the consumer (http://web.archive.org/web/20000511045940/www.dell.com/us/en/dhs/products/line_desktops.htm http://web.archive.org/web/20000511074752/www.dell.com/us/en/dhs/products/series_dimen_desktops.htm http://web.archive.org/web/20000618194040/www.dell.com/us/en/dhs/offers/offer_3x_offer02.htm). However, Henson does not teach a dynamic system in which the information regarding the business segment and performance level is used to present the user with a default system. However, Lynch-Freshner does teach a server that accepts parameters from a client and produces a window in accordance with the parameters with the use of a program, such as C++, that is executed by a computer (Column 4 Lines 60 – 66, Column 8 Lines 1 – 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Lynch-Freshner to modify Henson to include a dynamic system of receiving parameters, such as a business segment and performance level, from a user and producing a window in accordance with the parameters, such as a default system based on the selected business segment and performance level.

20. In regards to **claim 19**, Lynch-Freshner discloses a computer (Figure 3) programmed with C++ for the use of object-oriented programming techniques (Column

6 Lines 58 – 64). This, in turn, will allow the computer to accept parameters to create window objects in accordance with the parameters that were given (Column 4 Lines 65 – 66). Moreover, "If the particular parameters are not present the window is displayed using a default layering scheme, and the window takes on parameters associated with the already displayed windows (Column 5 Lines 9 – 12)."

Response to Arguments

21. Applicant's arguments filed 12/27/2006 have been fully considered but they are not persuasive.

Arguments towards 35 USC § 112, first paragraph

22. As previously discussed the applicant has not properly disclosed the process required to provide a default system that adequately reflects what the consumer needs. The applicant argues that all must be done is to multiply the variables together and a default system is offered. As discussed above, this process is flawed in that the same score would be provided, but with different default offers.

Further still, applicant argues, "Furthermore, although it is theoretically possible that variables for the embodiment described might be selected such that more than one high score might be obtained, such an outcome need not result." Although such an even need not result, examiner points out once again that due to the flaw in the system such an event will occur. Applicant also states that lower scores may be used, however, this does not remedy the problem of lower scores having the same values. Essentially, the examiner understands this to be that when the invention is confronted with this conflict it will carry out methods that are already old and well known in the art.

Moreover, applicants even admit on page 9 of the arguments that, "Applicant respectfully submits that one of ordinary skill in the art would be capable of determining how to resolve such conflicts of ensuring that such conflicts did not exist." However, applicant once again fails to provide how to remedy such a conflict without using what is obviously already known in the art.

As previously discussed, as well, the values given to these variables are subjective in that they will differ based on the individual who is inputting what these values should be. Moreover, as previously discussed, the values of these variables would further be subjective based on the business's need. As was discussed individuals would disagree as to what components would be best for a given business's practice.

Arguments towards 35 USC § 112, second paragraph

23. Rejections toward **claims 1, 3, 4, 5, 6, 10, 12, 13, 14, and 15** are **withdrawn** due to amendments.

24. Rejections toward **claims 7, 8, 16, and 17** are **maintained**.

Applicants disclose in Figure 4 (164) to validate components against inventory. Furthermore, applicant also states in ¶24, "One ore more default offerings for the product are dynamically determined using the segment variables, the performance variables and the inventory variables." Examiner understands this to mean that the inventory variable must be required, which is contrary to what applicant argues. Even more, in the event that not all the inventory variables are used this would result in providing false data. Applicants also state in ¶27, "Moreover, because the components

are validated against inventory, it can be assured that the default product being offered can be build rapidly." However, if only a portion of the inventory is being used then this would result in false information to the consumer. That is to say, if only a portion of the inventory variables are used and if only those portions with high numbers are shown the customer would assume that the product would be built rapidly. However, what if the low numbers, including 0, are not shown? The speed at which the product can be built is only as fast as the least available, if available, component.

Arguments towards 35 USC § 101

25. Applicant argues that the default(s) dynamically provided to the customer reflect the choices made by the vendor of the products as well as choices by the customer. However, this is incorrect. What if the customer is knowledgeable in the art? The vendor may display a product that may be rated at a different value than what the customer may know about. As a result, a vendor may change the numbers accordingly, but will result in always having an unpredictable result. A consumer may later want to upgrade a piece of equipment at a later date and find that all variables have changed and would result in having compatibility issues.

Furthermore, applicants also argue that there is no requirements that the default exactly match a customer preferences. Is this not what the invention is trying to attain? Applicants disclose in ¶27, "Thus, the default offerings and upgrades are dynamically determined based on a few selections by the customer. As a result, the default offerings and upgrades are more tailored to each individual customer." However, it seems that the applicants are arguments contradict with what is disclosed. Isn't the

invention trying to help a customer find a system that would work for what they need with little work on their part? Applicants argue that the customer is now supposed to assemble their own system. Examiner understands this to be that the invention is not capable of fulfilling its goal and, as a result, will have the customer do all the work when the invention fails, which seems to be the opposite of what the invention is trying to accomplish. Essentially, it appears that the customer needs to go through an unnecessary step of inputting various segments/variables only to realize that in the end of it all they will be required to assemble their own product.

Arguments toward 35 USC § 103

26. Applicants argue that Henson teaches that the customer is allowed to make a business segment selection upon checkout. However, this is not the case. Henson discloses that the business segment selected here is for payment and delivery purposes and not for the creation of the product. The NPL provided (Dell.com) clearly shows that the customer selects the business segment first, i.e. Home & Home Office, Small Business, and etc. Moreover, Figure 3A also discloses the use of performance levels to present the user with a default system.

27. In regards to the combination of Lynch-Freshner and Henson applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

28. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references use some type of parameters to produce some type of end product. Applicants' argument that Lynch-Freshner's parameters are not business segment or performance levels is irrelevant. Henson teaches that the parameters that would be used are business segment and performance levels. As far as whether the window should be a default system, the inventive concept taught by Lynch-Freshner to produce some type of output based on received input. It would have been obvious to one skilled in the art that the combination of Henson and Lynch-Freshner would still produce the same invention as what is claimed by the applicants, i.e. receiving parameters (Lynch-Freshner, as well as Henson receiving parameters from customers) from a source (Henson/customer regarding business type [Home, Small Business, etc.]) and producing some type of output based on those parameters (Lynch-Freshner).

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3/15/07

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